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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,436	11/14/2001	Avi J. Ashkenazi	P2730P1C14	2379

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EXAMINER	
KEMMERER, ELIZABETH	

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/990,436	ASHKENAZI ET AL.	
	Examiner	Art Unit	
	Elizabeth C. Kemmerer, Ph.D.	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *119-124* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *119-124* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 November 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 5/24/02
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Application, Amendments, And/Or Claims

The preliminary amendments received 14 November 2001 and 03 September 2002 have been entered in full. Claims 1-118 are canceled. Claims 119-124 are under examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 24 May 2002 has been considered by the examiner. However, since the Blast results cited therein are not true publications with a publication date, they are not fully in compliance with 37 CFR 1.97 and thus they will not be printed on the face of the patent issuing from this application.

Specification

The specification should be reviewed for improper recitation of hyperlinks. All such recitations should be deleted or amended such that the hyperlinks are rendered inactive. See MPEP § 608.01.

35 U.S.C. §§ 101 and 112, First Paragraph

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 119-124 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility.

The claims are directed to antibodies that bind a polypeptide corresponding to SEQ ID NO: 207, referred to in the specification as PRO1112. The utility and enablement of the antibody depends upon whether or not the polypeptide it binds has utility and enablement. The specification discloses that PRO1112 is a transmembrane polypeptide (p. 17) with weak sequence identity to a mycobacterium tuberculosis peptide, a H+-transporting ATP synthase and an MHC class II histocompatibility antigen. The specification does not assert that PRO1112 share any biological activities with any of these known polypeptides. The specification generally asserts that all of the disclosed PRO polypeptides will be useful for a number of purposes; however, none of these asserted uses meet the three-pronged requirement of 35 U.S.C. § 101 regarding utility, namely, that the asserted utility be credible, specific and substantial. The asserted utilities will each be addressed in turn.

1) the PRO polypeptide can be used to isolate other polypeptides to which it binds: This asserted utility is not specific or substantial. Since the same can be done with any polypeptide, the asserted utility is not specific to the claimed PRO1112 polypeptides. Furthermore, since the specification does not disclose how PRO1112 or its binding partners can be used, significant further research would be required of the

skilled artisan to determine how to use the claimed polypeptide or its binding partner. Since the asserted utility is not presented in a ready to use, real-world application, the asserted utility is not substantial.

2) the PRO polypeptide can be used as a molecular weight marker: This asserted utility is not specific. Since the same can be done with any polypeptide, the asserted utility is not specific to the claimed PRO1112 polypeptides.

3) the PRO polypeptide can be used in tissue typing: This asserted utility is not specific or substantial. With the exception of a few housekeeping genes, all polypeptides have a tissue specific pattern of expression, and thus virtually any polypeptide can be used in tissue typing. Thus, the asserted utility is not specific to PRO1112. Furthermore, the tissue-specific pattern of expression for PRO1112 is not disclosed. The skilled artisan would have to determine the tissue specific pattern of expression empirically. Thus, the asserted utility is also not substantial.

4) the PRO polypeptide can be used in therapy: This asserted utility is not specific or substantial. Since a defect in any polypeptide is likely to cause a disease of some sort, every polypeptide is a target for drug development. Thus, the asserted utility is not specific to the claimed PRO 1112 polypeptide. Furthermore, the specification does not disclose a nexus between any specific disease states and a change in amount or form of PRO1112. Significant further research would have to be conducted to identify such a nexus. Therefore, the asserted utility is not substantial.

5) the PRO polypeptide can be sued to identify agonists or antagonists: Since the same can be done with any polypeptide, the asserted utility is not specific to the

claimed PRO1112 polypeptides. Furthermore, since no activity has been assigned to PRO1112, the assays cannot be conducted until the specific biological activities of PRO1112 are determined empirically. Therefore, the asserted utility is also not substantial.

The specification also discloses that PRO1112 tested positive in the gene amplification assay (Example 170, pp. 539-555). This information provides a credible, specific and substantial utility for PRO1112 nucleic acids, but not for PRO1112 polypeptides or antibodies. The preliminary data in the specification were not supported by analysis of mRNA or polypeptide expression, for example. Also, the literature reports that it does not necessarily follow that an increase in gene copy number results in increased gene expression and increased polypeptide expression, such that the claimed antibodies that bind the recited polypeptides would be useful for diagnosis of cancer or as a drug target. For example, Pennica et al. (1998, PNAS USA 95:14717-14722) disclose that:

> "An analysis of *WISP*-1 gene amplification and expression in human colon tumors showed a correlation between DNA amplification and overexpression, whereas overexpression of *WISP*-3 RNA was seen in the absence of DNA amplification. In contrast, *WISP*-2 DNA was amplified in the colon tumors, but its mRNA expression was significantly reduced in the majority of tumors compared with the expression in normal colonic mucosa from the same patient."

See p. 14722, second paragraph of left column; pp. 14720-14721, "Amplification and Aberrant Expression of *WISPs* in Human Colon Tumors." See also Konopka (Proc. Natl. Acad. Sci. (1986) 83:4049-4052), who state that

> "Protein expression is not related to amplification of the abl gene but to variation in the level of bcr-abl mRNA produced from a single Ph1 template" (see abstract).

Finally, even if gene amplification correlates with increased transcription, it does not always follow that protein levels are also amplified. See Haynes et al. (1998, Electrophoresis 19:1862-1871), who studied more than 80 proteins relatively homogeneous in half-life and expression level, and found no strong correlation between polypeptide and transcript level. For some genes, equivalent mRNA levels translated into protein abundances which varied more than 50-fold. Haynes et al. concluded that the protein levels cannot be accurately predicted from the level of the corresponding mRNA transcript (p. 1863, second paragraph, and Figure 1). Therefore, the art indicates that it is not the norm that gene amplification, or even increased transcription, results in increased polypeptide levels.

Therefore, the asserted utility is not substantial, as the real-world use has not been established. Thus, the proposed use of the claimed antibodies that bind PRO1112 polypeptides are simply starting points for further research and investigation into potential practical uses of the polypeptides. See Brenner v. Manson, 148 U.S.P.Q. 689 (Sus. Ct, 1966), wherein the court held that:

> "The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

Claims 119-124 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

35 U.S.C. § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 119 and 124 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 119 recites an antibody that binds a polypeptide, whereas claim 124 recites an antibody that *specifically* binds the same polypeptide. Neither the art nor the specification provide a clear definition for, or distinction between, "binds" and "specifically binds". Therefore, the metes and bounds of the claimed invention cannot be determined.

Priority

Applicant's claim for priority under 35 U.S.C. 120 and 119(e) is acknowledged. However, the applications upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 119-131 of this application. Specifically, since the instant specification fails to provide a disclosure meeting the requirements of 35

U.S.C. §§ 101 and 112, first paragraph, the claim for priority to any parent application is denied. The instant filing date, 14 November 2001, is thus used for the purposes of applying prior art.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 119 and 124 are rejected under 35 U.S.C. 102(b) as being anticipated by Rolls et al. (1999, J. Cell Biol. 146:29-43).

Rolls et al. teach a polyclonal antibody that binds a polypeptide having a sequence identical to SEQ ID NO: 207 as recited in the instant claims. See Figures 4a and 4b, p. 35, and p. 31 "Antinurim Antibody Production."

35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 120-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rolls et al. in view of U.S. Patent 5,874,082 to De Boer.

As discussed above, Rolls et al. teach a polyclonal antibody that binds a polypeptide having a sequence identical to SEQ ID NO: 207 as recited in the instant claims. See Figures 4a and 4b, p. 35, and p. 31 "Antinurim Antibody Production."

Rolls et al. do not teach the antibody forms recited in claims 120-123, namely, monoclonal antibodies, humanized antibodies, antibody fragments, or labeled antibodies.

However, such forms of antibodies were routinely made and used in the art at the time of the invention. For example, De Boer discloses these forms of antibodies at column 3, second paragraph and column 7, fourth paragraph.

Therefore, it would have been obvious to one of ordinary skill in the art at the tie of the invention to modify the antibodies taught by Rolls et al. such that the antibodies were monoclonal, humanized, fragments and/or labeled as disclosed by De Boer with a reasonable expectation of success. The motivation to do so is given by De Boer, who disclose that humanized monoclonal antibodies are particularly useful in therapeutics, since there is a lower chance of immune reaction when administered to a human (col. 3,

2nd paragraph), fragments are equivalent to full antibodies (col. 3, 2nd paragraph) and labels are useful for visualization (col. 7, 4th paragraph).

Thus, the claimed invention as a whole was *prima facie* obvious over the combined teachings of the prior art.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth C. Kemmerer, Ph.D. whose telephone number is (571) 272-0874. The examiner can normally be reached on Monday through Thursday, 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne L. Eyler, Ph.D. can be reached on (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elizabeth C. Kemmerer

ECK

ELIZABETH KEMMERER
PRIMARY EXAMINER